

In re Application of:  
Tamburini et al.  
Application No.: 09/974,026  
Filed: October 10, 2001  
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Attorney Docket No.: AERO1130-4

**REMARKS**

**Rejection Under 35 USC § 112, First Paragraph (Written Description)**

A. Applicants have shown that the instant application is *identical* to the prior parent application (or U.S. Application No. 09/144,428, or U.S. Patent No. 6,583,108), and therefore a safeguard statement incorporating the parent application by reference is not necessary and the application is a continuation prosecution application of the parent containing no new subject matter.

According to the Office Action, Applicants have the burden of explaining the inconsistency between the instant continuation written description and that of the parent written description (PCT/US/US97/03894 or U.S. Patent No. 6,583,108).

To this end, Applicants have carefully reviewed the instant continuation application to that of the parent application (or 09/144,428) , which is a U.S. national phase application of the PCT/US/US97/03894 under 35 USC §371, filed March 10, 1997 (see U.S. Patent No. 6,583,108). Further, Applicants have also carefully compared PCT/US/US97/03894 application to that of the published U.S. Patent No. 6,583,108. All applications contain the *identical* written description including the same: Title, Abstract, Field of the Invention, Background of the Invention, Brief Summary of the Invention, Description of the Drawings, FIGs. 1-14, Detailed Description, and Sequence Listing of the Invention including all examples, tables and formulas incorporated therein. In short, the instant application is a true continuation prosecution application as filed under 37 USC 15.3(d), claiming benefit of an earlier filing date in the United States under 35 U.S.C. §120 to 09/144,428.

Applicants note that instant application does not include a statement incorporating by reference 09/144,428 (or U.S. Patent No. 6, 583, 108) in its entirety, because the instant application is a mere copy of the prior application (or PCT/US97/03894, now U.S. Patent No. 6, 583, 108). Further proof of this is shown in the filing transmittal, a copy of the first page which

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was retrieved from PAIR and is attached as Exhibit A. Therefore, since the instant application properly claims benefit of an earlier U.S. filing date to 09/144,428, and the two applications are *identical*, there is no need to “incorporate by reference” all that is in 09/144,428.

B. The Office Action concedes that the parent application teaches activity of SEQ ID NOs: 5, 7 and 8, and because the instant application properly claims benefit to the parent application (or 09/144,428) and is identical to 09/144,428, it must also be true that the instant application discloses the same activity of SEQ ID NOs: 5, 7 and 8.

According to the Office Action the “current application is a *continuation* of 09/144,428, which has taught activity of SEQ ID NOs: 5, 7 and 8 polypeptides but not in the specification of the instant application (page 3 of Office Action).” Applicants respectfully traverse this written description rejection.

As stated above, the instant application, a continuation prosecution application is *identical* to that of the 09/144,428 and there is *no inconsistency* between the two applications. Therefore, because there is no inconsistency between the instant application and that of 09/144,428, if the 09/144,428 teaches activity for SEQ ID NOs: 5, 7 and 8 polypeptides, so must the instant application.

Accordingly, all claims are in condition for allowance, and such action is hereby respectfully requested.

C. The claims are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which allegedly was not described in the instant specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

According to the Office Action, although Applicants were in possession of the nucleic acid sequences SEQ ID NOs: 5, 7, and 8, Applicants are not in possession of function the SEQ ID NOs: 5, 7, and 8, thereof. Applicants respectfully traverse this rejection.

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As stated above, Applicants have shown that because the instant application is *identical* to 09/144,428, and since 09/144,428 teaches activity of SEQ ID NOs: 5, 7 and 8 polypeptides, so must the instant application. Thus, Applicants *are* in possession of function the SEQ ID NOs: 5, 7, and 8.

In view of the foregoing, the present specification contains a complete description of the invention sufficient to demonstrate that the Applicants, at the time the application was filed, had possession of SEQ ID NOs: 5, 7 and 8 polypeptides and their function. Accordingly, it is respectfully submitted that the rejection of claims 12-17 under 35 U.S.C. § 112, first paragraph, as allegedly lacking adequate written description, is not properly applied. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

### CONCLUSION

In view of the above amendments and remarks, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved, the Examiner is requested to contact the undersigned at the telephone number given below so that a prompt disposition of this application can be achieved. No fee is believed due in connection with this Response. However, the Commissioner is hereby authorized to charge any fees that

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may be associated with this communication, or credit any overpayment to Deposit Account  
No. 07-1896.

Respectfully submitted,



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Date: February 15, 2005

Lisa A. Haile, J.D., Ph.D.  
Registration No.: 38,347  
Telephone: (858) 677-1456  
Facsimile: (858) 677-1465

**USPTO CUSTOMER NUMBER 28213**  
DLA PIPER RUDNICK GRAY CARY US LLP  
4365 Executive Drive, Suite 1100  
San Diego, California 92121-2133

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